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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/768,504

01/30/2004

Jeffrey Allan Thompson

1828

6876

27310

7590

09/26/2006

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EXAMINER

MEHTA, ASHWIN D

ART UNIT

PAPER NUMBER

1638

DATE MAILED: 09/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/768,504

Applicant(s)

THOMPSON, JEFFREY ALLAN

Examiner

Ashwin Mehta

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                  |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>4302004</u> . | 6) <input checked="" type="checkbox"/> Other: <u>Request under 37 CFR 1.105</u> .       |

## **DETAILED ACTION**

### ***Specification***

1. The meanings of several items in Table 1 are unclear. It is unclear what the abbreviations, "RR," "STS," and "HYPLSC" stand for. Further, it is unclear what the number 8 means in relation to average field emergence, what the number 7 means for average hypocotyl length, and what "L" means regarding hypocotyl length. Correction/clarification is required. New matter must be avoided.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 7: the claims are indefinite for the recitation, "XB44D04". This is an arbitrarily assigned name for a soybean variety. It does not define any traits possessed by the variety. This name can also be changed or arbitrarily assigned to any other plant line. Inclusion of the ATCC accession number into the claims will obviate the rejection.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 1638

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The claims are broadly drawn towards seed of soybean line XB44D04; or a soybean plant, or a part thereof, produced by growing said seed; tissue culture of regenerable cells from said soybean plant; a soybean plant regenerated from the tissue culture and having all the morphological and physiological characteristics of XB44D04; and method for producing a progeny soybean plant comprising crossing XB44D04 with a different soybean plant.

The claimed seed of soybean variety XB44D04 is essential to the claimed invention. It must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If the seed is not so obtainable or available, a deposit thereof may satisfy the requirements of 35 U.S.C. 112. The specification does not disclose a repeatable process to obtain the exact same seed in each occurrence and it is not apparent if such a seed is readily available to the public. A deposit of the seeds of inbred soybean line XB44D04 with an acceptable depository is required.

If a deposit is made under the terms of the Budapest Treaty, then a statement, affidavit or declaration by Applicants, or a statement by an attorney of record over his or her signature and registration number, or someone empowered to make such a statement, stating that the instant

invention will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

If a deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809 and MPEP 2402-2411.05, Applicant may provide assurance of compliance by statement, affidavit or declaration, or by someone empowered to make the same, or by a statement by an attorney of record over his or her signature and registration number showing that:

(a) during the pendency of the application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the enforceable life of the patent, whichever is longer;

(d) the viability of the biological material at the time of deposit will be tested (see 37 CFR 1.807); and

(e) the deposit will be replaced if it should ever become inviable.

### ***Claim Rejections - 35 USC § 102 & 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rhodes (U.S. Patent No. 6,180,851, issued January 30, 2001).

The claims are broadly drawn towards seed of soybean line XB44D04; a soybean plant or a part thereof produced by growing said seed; tissue culture of regenerable cells produced from said plant; a method comprising crossing said plant with a different soybean plant.

Rhodes teaches seeds and plants of soybean variety 947262951112. It appears that this variety is the same as instant soybean variety XB44D04. Many traits listed in the variety description information for 947262951112 in column 5, such as black hilum color, white flower color, brown pod color, tawny pubescence color, maturity group 4, are also possessed by XB44D04. Instant Table 1 indicates that XB44D04 has resistance to the "RR" herbicide. It is unclear what "RR" stands for (see the objection above). However, 947262951112 has resistance to Roundup Ready<sup>TM</sup> herbicide, and soybean cyst nematode race 3. Other traits, such maturity subgroup, yield, are affected by environmental effects on plant growth. The patent is silent regarding resistance or susceptibility to races 4, 7, and 25 of phytophthora root rot, soybean cyst nematode races 1 and 5, sudden death syndrome. The USPTO does not have sufficient facts to determine if all other unrecited Mendelian traits possessed by 947262951112 and XB44D04 are the same, or if their genomes are the same. The USPTO cannot conclude that the subject matter

Art Unit: 1638

of the claims would have been obvious since it cannot determine whether the genomes of the soybean varieties differ. The USPTO/examiner is not in a position to make either a conclusion of “inherency/anticipation” or “obviousness” since the record does not allow one to determine if and how the instantly claimed subject matter differs from the prior art. Accordingly, the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best* 195 USPQ 430, 433 (CCPA 1977). Rhodes teaches crossing 947262951112 with other soybean plants, wherein the first or second parent plant is 947262951112; tissue culture of cells of plant 947262951112, and soybean plants regenerated from the tissue culture having all of the morphological and physiological characteristics of 947262951112 (claims). It would have been obvious to choose any regenerable cell from which to make the tissue culture, for example leaf or flower, as regenerable cells are needed to generate a plant.

5. Claims 1-8 are rejected.

#### ***Contact Information***

Any inquiry concerning this or earlier communications from the Examiner should be directed to Ashwin Mehta, whose telephone number is 571-272-0803. The Examiner can normally be reached from 8:00 A.M to 5:30 P.M. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s supervisor, Anne Marie Grunberg, can be reached at 571-272-0975. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO’s Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to

Art Unit: 1638

confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

September 18, 2006

A handwritten signature in black ink, appearing to read 'Ashwin D. Mehta', is positioned above the printed name.

Ashwin D. Mehta, Ph.D.  
Primary Examiner  
Art Unit 1638



**ATTACHMENT TO OFFICE ACTION**

**Request for Information under 37 CFR § 1.105**

1. Applicant and the assignee of this application are required under 37 CFR § 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

2. This request is being made for the following reasons:

Applicant is claiming a seed, plant, or parts thereof, of soybean variety "XB44D04:"a method for producing progeny soybean plants comprising crossing XB44D04 with a different soybean plant, **but** the instant specification is silent about what starting materials and methods were used to produce soybean line XB44D04. The requested information is required to make a meaningful and complete search of the prior art.

3. In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

(i) What were (are) the original parental soybean lines used to produce soybean line XB44D04? Please supply all of the designations/denominations used for the original parental soybean lines and line XB44D04. Please supply information pertaining to the lineage of the original parental lines back to any publicly available varieties.

(ii) What method and method steps were used to produce soybean line XB44D04?

(iii) At or before the time of filing of the instant application or any provisional application to which benefit is claimed, had any of said parental soybean lines or progeny therefrom been disclosed or made publicly available? If so, under what

Art Unit: 1638

designation/denomination and under what conditions were said parental soybean lines or progeny disclosed or made publicly available and from when to when?

(iv) At or before the time of filing of the instant application or any provisional application to which benefit is claimed, were any other soybean lines produced by said method using said original parental soybean lines, and if so, had said produced soybean lines been publicly available or sold? If so, under what designation/denomination and under what conditions were said other soybean lines disclosed or made publicly available and from when to when?

3. If Applicant views any or all of the above requested information as a Trade Secret, then Applicant should follow the guidance of MPEP § 724.02 when submitting the requested information.

4. In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure. Please indicate where the relevant information can be found.

5. The fee and certification requirements of 37 CFR § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR § 1.105 are subject to the fee and certification requirements of 37 CFR § 1.97.

Art Unit: 1638

6. The Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR § 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.

7. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

  
ANNE MARIE GRUNBERG  
SUPERVISORY PATENT EXAMINER